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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/742,520	11/01/96	UNGCHUSRI	T 63-11607

PM92/0210

EXAMINER

FMC CORPORATION  
INTELLECTUAL PROPERTY LAW DEPT  
1735 MARKET STREET  
PHILADELPHIA PA 19103

SHACKELFORD, H

ART UNIT PAPER NUMBER

3671

35  
02/10/00

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. <b>08/742,520</b>	Applicant(s) <b>UNGEHUSRI</b>
	Examiner <b>H. SHACKELFORD</b>	Group Art Unit <b>3671</b>

Responsive to communication(s) filed on Nov. 19, 1999

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1, 3, 4, 12-19, and 21-27 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) 1, 3, 4, 12-19, and 21-26 is/are allowed.

Claim(s) 27 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3671

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 27 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 27 claims that "the diameter of the races are determined as a function of the radius of the ball bearings and the cross-sectional areas of the male and female connectors at each race."

However, the specification does not enable the determination of the diameter of the races. No where in page 4, lines beginning at line 14 discuss the diameter of the races. Is the "length of race radii" the same as the diameter of races? If so, the terms in the specification and the claims should be consistent.

3. Claim 27 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Talafuse.

Talafuse discloses all of the definite structure claimed. Applicant should note that how the diameters are determined is considered to be a method limitation and not given patentable weight in a product claim.

In the alternative, IF this limitation is to be given weight, it would have been an obvious to use the function of the radius of the ball bearings and the cross sectional areas of the

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connectors to determine the diameter since they appear to be merely obvious parameters to determine the diameter of the races.

4. Claims 1, 3, 4, 12-19, 21-26 are allowed.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to H. Shackelford whose telephone number is (703) 308-2978.



**H. SHACKELFORD  
PRIMARY EXAMINER  
GROUP 3600**

hcs  
February 1, 2000